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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/290,170	04/13/1999	HIROSHI ARITA	H-7769	9549

24956 7590 03/03/2003

MATTINGLY, STANGER & MALUR, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER

FLEMING, FRITZ M

ART UNIT PAPER NUMBER

2182

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/290,170

Applicant(s)

ARITA ET AL.

Examiner

Fritz M. Fleming

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 38-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

  
FRITZ FLEMING  
PRIMARY EXAMINER  
GROUP 2100

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-15-03 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the measuring equipment near the border and the measuring equipment in each country must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 38-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See below.

5. Claims 38-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See below.

6. Claims 38-67 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for measuring on a path, does not reasonably provide enablement for the measuring to take place near a border and within a country. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See below.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 38-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The area of concern is the claim 38 and 45 placing of the measuring equipment near a border of the first/second country and the settlement based upon measuring equipment in each country. First of all, it appears as though the word "borders" is not in the specification at all, based upon a text search of the published application. Thus it is entirely unclear how one is to interpret "near a border". This would also be new matter,

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as the concept of placing the measuring equipment in a country near a border is simply not contained within the confines of the originally filed application. For example, turning to the specification and the discussions of Figures 3,4,6, it is simply nowhere to be found how the measuring equipment is to be considered to be within a country near a border of the same country. On the contrary, the measuring equipment is specifically shown to be outside the confines of any country or system and on the path. There is simply no disclosure to place the measuring equipment in a country near a border. The question then expands to what configuration is to be consulted for the settlement based upon the arranged measuring equipment. The claims simply do not accurately reflect the disclosed embodiments as shown in Figures 3,4,6 and the measuring equipment on a path, as to do what is claimed, it requires the use of two measuring equipments and such cannot be between two countries or systems. Per the disclosure, only one measuring equipment is between any two countries, so to have a settlement based upon two measuring equipments, would require energy to go through a third system/country as this is the only way to get two measuring equipments. For example, the Figure 3 disclosure has a single measuring equipment between any two systems/countries. Thus a settlement cannot be determined between two countries (as claimed) as a third country has to be involved in order to have two measuring equipments. Thus a settlement has to involve a third country to bring in the second measuring equipment. Accordingly, the newly submitted claims are clearly new matter. Since the claims are new matter and unsupported by the specification, there is clearly a lack of enablement and a lack of an adequate written disclosure. There is simply no

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teaching in the disclosure to teach the "near the border" and the settlement determined by two measuring equipments in two countries near the borders of such. Thus the scope of enablement is also improper, as what is enabled is not what is claimed.

Finally, due to the issues raised above, the claims are vague and indefinite as the metes and bounds of the claims are not determinable. The claims in and of themselves are understandable, but they cannot be interpreted properly in light of the specification. The examiner will go on record to state that the claims as written would be allowable, as they define over the art of record. The art of record is replete with global grids and transnational interconnections. The admitted prior art per the JEPSON drafting of the initially filed claims put the measuring equipment on the path into the realm of the prior art. However, to place measuring equipment in a country near a border and then to base a settlement on two of such (i.e. two countries and a measuring equipment in each country near its border) is not taught within the prior art. However, the examiner does not see how such can be introduced into this application, due to issues of new matter. It is incumbent upon applicants to show (if possible) how each limitation is shown, adequately described and properly enabled in the confines of the originally filed specification. The examiner sees such as not being possible and suggests the filing of a CIP to overcome these issues.

### ***Conclusion***

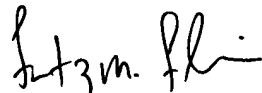
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JUGL shows another transnational distribution system.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz M. Fleming whose telephone number is 703-308-1483. The examiner can normally be reached on M-F 0630-1500.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Fritz M. Fleming  
Primary Patent Examiner  
Art Unit 2182

fmf  
February 26, 2003